

**Remarks**

Favorable reconsideration of this application is requested in view of the above amendments and in light of the following remarks and discussion.

Entry of this response is requested, as the response places the application in clear condition for allowance or alternatively places the claims in better form for appeal. Specifically, independent claims are amended to receive additional features, including features of previously presented dependent claims, which place the claims in condition for allowance.

Claims 1, 6, 14, and 15 are pending in the application. Independent Claims 1, 6, and 14 are amended, and Claims 8-13 and 16-20 are canceled without prejudice or disclaimer.

In the Office Action Claim 16 is objected to; Claims 14-19 are rejected under 35 U.S.C. § 1902(b) as being anticipated by U.S. Patent No. 2,156,277 to Corbin, Jr. (Corbin); Claims 1 and 8-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,055,787 to Gerhafer et al. (Gerhafer) in view of U.S. Patent No. 4,001,997 to Saltzman, and further in view of Corbin; Claims 6 and 11-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gerhafer in view of Saltzman and Corbin, and further in view of Japanese Publication No. 10-088769 to Hideki; and Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Corbin in view of Gerhafer.

As stated above Claim 16 is objected to. In response, Claim 16 is canceled, thereby mooting the objection.

With respect to the rejection of independent Claim 1, the present invention is directed to a ceramic siding board for clapboard boarding. The independent claim recites a lateral overlying tongue portion disposed on one of the right and left sides of the ceramic siding board, the lateral overlying tongue portion configured to form a shiplap joint by overlying a tongue portion of an adjacent siding board, and a lateral underlying tongue portion disposed

on the other one of the left and right sides of the ceramic siding board, the lateral underlying tongue portion configured to form a shiplap joint by lying under a tongue portion of an adjacent siding board.

The use of the ceramic material and the laterally overlying and underlying tongue portions configured to form shiplap joints with tongue portions of adjacent siding boards can provide numerous advantages. By way of specific non-limiting examples, the ceramic material and shiplap joints can provide superior weatherability and durability, while the use of the ceramic material can permit formation of various concave and convex patterns to obtain a large variety of external appearance designs, by very easily embossing and grinding the ceramic siding board.<sup>1</sup>

MPEP § 2143.01 requires that “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” In this case, it is submitted that there is no required teaching, suggestion, or motivation to combine the teachings of the references.

Gerhafer is directed to an externally suspended facade system. It is submitted, however, that Gerhafer does not disclose or render obvious the claimed features of laterally overlying and underlying tongue portions configured to form shiplap joints with tongue portions of adjacent siding boards, as recited in independent Claim 1.

Because Gerhafer does not disclose the claimed features of the overlying and underlying tongue portions of the ceramic siding board, Gerhafer is unable to provide the advantages provided by the claimed invention, including the provision of superior weatherability and durability provided by the ceramic material and the shiplap joint, as well

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<sup>1</sup> Page 22, line 24 to page 23, line 3; and page 8, lines 1-7, of Applicants’ originally filed application.

as the ability to receive various concave and convex patterns to obtain a large variety of external appearance designs, by very easily embossing and grinding the ceramic siding board.

Saltzman is directed to a resin molded siding member. It is submitted, however, that Saltzman does not disclose or render obvious the claimed features of the overlying and underlying tongue portions of the ceramic siding board, and further does not even disclose or render obvious the ceramic material, as recited in independent Claim 1. Therefore, it is submitted that Saltzman is also unable to provide the above-discussed advantages.

Hideki is directed to an installing structure of decorative girth. However, it is submitted that the decorative girth of Hideki is vastly different from the claimed ceramic board structure. Therefore, it is submitted that Hideki is also unable to provide the advantages provided by the claimed invention.

Corbin is directed to a metal shingle. The metal shingle of Corbin is also vastly different from the claimed ceramic board. Therefore, it is submitted that Corbin is also unable to provide the advantages provided by the claimed invention, including the provision of superior weatherability and durability while also providing the ability to receive various concave and convex patterns to obtain a large variety of external appearance designs by embossing and grinding. Specifically, because the metal shingle of Corbin appears to be a relatively thin, generally flat plate, the metal shingle is unable to be embossed and ground to obtain a large variety of external appearance designs.

It is submitted that the rejection of independent Claim 1 is based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicants' structure as a template and selecting elements from the references to fill in the gaps.<sup>2</sup> Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage,

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<sup>2</sup> *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness.<sup>3</sup> Further, it is submitted that the "fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness."<sup>4</sup> Therefore, it is submitted that an improper "obvious to try" rationale is being applied in the Office Action.<sup>5</sup> Specifically, it is submitted that none of the applied references disclose or render obvious the desirability of the claimed features of a ceramic siding board including laterally overlying and underlying tongue portions configured to form shiplap joints with tongue portions of adjacent siding boards, capable of providing the above advantages. It is therefore submitted that Office Action has not established a *prima facie* case of obviousness, and therefore it is requested that the rejections of independent Claim 1 under 35 U.S.C. § 103(a) be withdrawn.

Independent Claims 6 and 14 are allowable for reasons similar to those discussed above with respect to independent Claim 1.

Claim 15 depends from independent Claim 14, and is therefore also allowable for at least the same reasons as the independent claim.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1, 6, 14, and 15 is earnestly solicited.

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<sup>3</sup> *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

<sup>4</sup> See Heading under MPEP 2143.01.

<sup>5</sup> See MPEP 2145 X.B.

Application No. 10/753,338  
Reply to Office Action of January 27, 2005

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below listed telephone number.

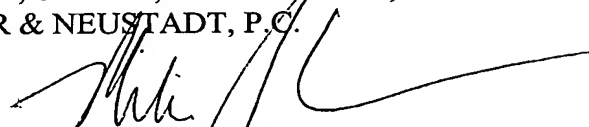
Customer Number

**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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Gregory J. Maier  
Registration No. 25,599  
Attorney of Record

Philip J. Hoffmann  
Registration No. 46,340

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